

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-7, 9-20, 22-28 are pending in the application, with claims 1 and 17 being the independent claims. Claims 8 and 21 are were previously cancelled without prejudice to or disclaimer of the subject matter therein. Claims 1, 4, 17, and 20 are sought to be amended without prejudice to or disclaimer of the subject matter therein. No new claims are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Objection to the Claims***

The Examiner has objected to claims 4 and 20 due to a grammatical error. The error has been corrected in each instance in the amended claim set. Withdrawal of these objections is respectfully requested.

***Rejections under 35 U.S.C. § 112***

Claims 1-7, 9-20, and 22-28 have been rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter. Applicant respectfully traverses and requests reconsideration.

With respect to independent claims 1 and 17, the Examiner contends that the segmentation and segmentation points, as claimed in step (f) of claim 1 and step (g) of

claim 17, serve no purpose in the invention. Further, the Examiner contends that it is unclear how a shifting of the segment point is performed with respect to step (f) of claim 1 and step (g) of claim 17.

The Applicant has amended claim 1 and claim 17 to recite "...masking the bad scan path..." in steps (d) and (e), respectively. Masking implies the input or code necessary to drive the inputs to a buried start point, or segmentation point, to known values, regardless of the status of previous segments. Masking restarts the scan test, isolating the segment of the scan path immediately following the segmentation point.

Further, with respect to independent claims 1 and 17, the Examiner contends that "...tracing the source errors...", as recited in step (e) of claim 1 and step (f) of claim 17, should be more restrictive, and restated to specify tracing only that portion of the scan path following the segment point. Claims 1 and 17 have been amended accordingly.

Finally, with respect to independent claims 1 and 17, the Examiner contends that it is unclear how, as specified in claims 1(a) and 17(a), "...other scan paths within the plurality of scan paths...considered to be good scan paths..." can contribute to test results that effect, as specified in original claims 1(e) and 17(f), "...tracing the source of errors of the bad scan path...". And how these test results would further effect, as specified in original claims 1(f) and 17(g), "...shifting the segment point of the bad scan path...". Applicant directs the Examiner to paragraph [0043] that describes how the errors on the good scan path are considered, in particular paragraph [0043] indicates a methodology by which the segment point is shifted based on the error on a good scan path.

The indefinite concerns raised by the Examiner relative to independent claims 1 and 17 have either been explained or amendments made to address the concerns. Withdrawal of these 35 U.S.C. 112, second paragraph, rejections is respectfully requested. Reconsideration and allowance of independent claims 1 and 17 is respectfully requested.

Claims 2-7, 9-16, and 18-20, 22-28 are dependent on independent claims 1 and 17, respectively. For at least these reasons, dependent claims 2-7, 9-16, and 18-20, 22-28 are also patentable over the rejections of indefiniteness. Reconsideration and allowance of dependent claims 2-7, 9-16, and 18-20, 22-28 is respectfully requested.

***Rejections under 35 U.S.C. § 103***

Claims 1-7, 10, 20, and 22-28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over P. Martin-de-Nicolas et al., "Method and Apparatus for Determining the Failing Operation of a Device-Under-Test", U.S. Patent Publication No. US 2003/0208710 A1, November 6, 2003 ("MdN") in view of Applicant Admitted Prior Art ("AAPA"), disclosed in the specification for the Applicant's invention. Applicants respectfully traverse and request reconsideration.

Claim 1 includes the element of shifting the segment point based on errors generated both on the bad scan path and the good scan paths ("Shifting Element"). The Examiner appears to recognize this element as being novel in the 35 U.S.C. 112 rejection, but has been confused by the Applicant. In response to the 35 U.S.C. 112 rejection, the Applicant has further clarified how good scan path results are factored

into the process of shifting the segment point. With this clarification in mind, Applicant argues that neither MdN nor AAPA disclose this element.

Furthermore, with respect to the Examiner's arguments rejecting claim 9, the Examiner states that MdN does not teach a determination of the number of errors generated by the bad scan path following the segment point and each of the good scan paths. Office Action at 14. Given that the Examiner acknowledges that MdN does not teach a determination of the number of errors generated by the good scan paths, it follows that MdN can not shift a segment point based on errors on the good scan paths.

Claim 9 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over MdN, in view of AAPA as applied to claim 1, and further in view of M. Akita, "Error Correction Method and Error Correction Circuit", U.S. Patent No. 5,541,940, July 30, 1996 ("Akita") and H. Sugimoto et al., "Drive, Method for Reading Data, Information Recording Medium Reproduction Apparatus, and Method for Reproducing Data Having Reading Errors", U.S. Patent No. 6,999,386, B2, February 14, 2006 ("Sugimoto"). Neither Akita or Sugimoto disclose the shifting element, and therefore do not cure the shortcomings of MdN and AAPA in teaching, suggesting or disclosing the shifting element.

For at least these reasons, independent claim 1 is patentable over the cited references. Independent claim 17 includes this same element. Thus, independent claim 17 is also patentable over the cited references. Reconsideration and allowance of independent claims 1 and 17 is respectfully requested.

Claims 2-7 and 9-16 are dependent on independent claim 1, while claims 18-20 and 22-28 depend on claim 17. Arguments supporting the patentability of claims 1

and 17 have been made in the preceding paragraphs. For at least these reasons, dependent claims 2-7, 9-16, 18-20, and 22-28 are also patentable over the cited references. Reconsideration and allowance of dependent claims 2-7, 9-16, 18-20, and 22-28 is respectfully requested.

### ***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Michael D. Specht".

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Date: 3/19/07

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